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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,071	02/08/2002	Jens Erik Sorensen	52-173	3616

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EXAMINER

MOONEYHAM, JANICE A

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/072,071

Applicant(s)

SORENSEN ET AL

Examiner

Jan Mooneyham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2002 and 21 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 36-47 is/are rejected.
- 7) ☒ Claim(s) 48-51 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the applicant's communication filed on February 8, 2002 and the preliminary amendment filed on October 21, 2002. Claims 1-35 were cancelled by preliminary amendment on October 21, 2002. Claims 36-51 are currently pending.

Information Disclosure Statement

2. The information disclosure statements (IDS) submitted on August 19, 2002, October 21, 2002, and July 27, 2004 are being considered by the examiner.

3. The information disclosure statement filed March 4, 2003 (International Preliminary Examination Report) fails to comply with 37 CFR 1.98(a)(1), which requires a list of all patents, publications, or other information submitted for consideration by the Office. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Objections

4. Claims 48-51 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim can not depend on any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 49-51 have not been further treated on the merits.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 37-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. What does the applicant mean by "providing said contingent contractual rights in

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an on-line marketable format?" How is the format an electronically tradable certificate? How is the online transfer, sale or auction enabled? How are the contractual rights marketed?

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 36-40 and 42-43 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 36-40 and 42-43 only recite an abstract idea. The recited steps of managing ideas by maintaining a computer database and exchanging property rights or transferring property rights in exchange for contractual obligations does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of pencil and paper. These steps only constitute an idea of how to manage

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ideas. There is no positive recitation of technology in the body of the claims. Looking at the claims as a whole, nothing in the body of the claim recites any structure or functionality to suggest that a computer performs the recited steps.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 36-47 are rejected under 35 U.S.C. 102(e) as being anticipated by Powell (US 2004/0220881)(hereinafter referred to as Powell).

Referring to Claims 36, 40-43 and 44:

Powell discloses a method and medium for performing the method of managing ideas, comprising the steps of:

maintaining a computer database for accumulating ideas for prospectively patentable inventions (Fig. 2 -FDI database (261), page 8 [0088, 0091, 0092, 0093], page 8 and 9 [0100], page 10 [0111], Figs. 9a and 9b,);

in exchange for transfer of property rights under patent rights to prospectively patentable inventions derived at least in part from the accumulated ideas, or in exchange for contractual obligations to transfer said property rights, providing contingent contractual rights to a portion of anticipate income derived from said property rights (abstract, Fig. 12a, 13, 18a, 19, page 1

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[0008], page 2 [0012-0015], page 7 [0082], pages 18-19 FDI: Toy Concept [0201], pages 19-21 [0203-0212]).

Referring to Claims 37, 40-43 and 45:

Powell discloses a method and medium wherein the exchange step comprises the step of providing contingent contractual rights in an on-line marketable format (page 2 [0012]).

Referring to Claims 38, 40 and 46:

Powell discloses a method and medium wherein the format is an electronically tradable certificate (page 3 [0024 – an assignment or license can be transferred, page 14 [0161])

Referring to 39, 40 and 47:

Powell discloses a method and medium wherein the provision of contractual rights comprises the step of enabling on-line transfer, sale, and or auction of the contingent contractual rights (page 2 [0018], page 3 [0024-0025])

Referring to Claim 40:

Powell discloses a method further comprising the step of marketing said contingent contractual rights (page 2 [0012] thru page 5 [0046])

Referring to Claim 41:

Powell discloses a method wherein a computer system facilitates use of contributor computers to make on-line contributions of said ideas to the computer database and wherein the exchange comprises the step of providing said contingent contractual rights by on-line communications between the computer system and the contributor computers (page 2 [0012] thru page 5 [0046]).

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Referring to Claim 42:

Powell discloses a method and medium wherein said ideas are systematically accumulated prior to filing any patent applications for inventions respectively derived at least in part from said accumulated ideas (page 18 [0201] thru page 21 [0214]).

Referring to Claim 43:

Powell discloses a method and medium wherein said ideas include needs and/or requirements of said inventions (page 25 [0234-0237])

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kanevsky discloses a web based method and system for collaborative invention creations with an idea development database and a rights negotiation wherein the co-inventors negotiate for the rights in any patent.

The four phases of innovation discloses building on other's ideas and generating the maximum number of possibilities.

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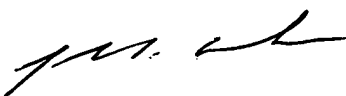
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan Mooneyham whose telephone number is (703) 305-8554.

The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jm


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